

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed September 15, 2008. At the time of the Final Office Action, Claims 9-16 were pending in this Application. Claims 9-16 were rejected. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Claims 9-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over PCT Publication 98/30053 filed by Holmstrom *et al.* (“*Holmstrom*”) in view of U.S. Patent No. 6,009,338 issued to Yuji Iwata *et al.* (“*Iwata*”). Applicant respectfully traverses and submit the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Holstrom and *Iwata*, separately or as combined by the Examiner, each fail to teach or suggest all the elements of the pending Claims. For example, Independent Claim 9 recites, in part:

at least one database stored in the nonvolatile memory and, *each of the at least one database being respectively assigned to precisely one of the at least one electronic telephone directory.* (Emphasis Added).

Holstrom fails to teach or suggest the above-recited element, as agreed upon by the Examiner. (Office Action, Page 2). *Iwata* also fails to teach or suggest the elements of Claim 9. The Examiner notes that “each *entry of a telephone directory (e.g., MATSUURA JIRO) being assigned to precisely a corresponding expansion telephone directory entry* having a data filed of variable size with respect to a number of additional attributes assigned to the telephone entry.” *Id* (Emphasis added). An entry in a telephone directory can not be construed as a database. Therefore, the Examiner has failed to show that *Iwata* discloses each of the at least one *database* being respectively assigned to precisely one of the at least one electronic telephone directory. Applicant believe the cited portions of *Iwata* by the Examiner fails to teach or suggest the above-recited element.

For at least these reasons, Claim 9 and its dependent claims are patentably distinct over the cited reference(s). Applicant respectfully requests reconsideration and allowance of Claim 9 and all claims that depend therefrom.

Association of Customer Number and Change of Correspondence Address

Applicant respectfully requests that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to Andreas Grubert at 512.322.2545. A Revocation and Power is being filed herewith.

CONCLUSION

Applicant has now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending Claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants

A handwritten signature in black ink, appearing to read 'A. Grubert', with a stylized flourish at the end.

Andreas Grubert
Reg. No. 59,143

Date: December 12, 2008

SEND CORRESPONDENCE TO:

Baker Botts L.L.P.

CUSTOMER ACCOUNT NO. **31625**

512.322.2545

512.322.8383 (fax)